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10/596,266	06/07/2006	Hans Peter Weitzel	WAS0768PUSA	4695
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BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			KOLLIAS, ALEXANDER C	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,266	<b>Applicant(s)</b> WEITZEL ET AL.	
	<b>Examiner</b> ALEXANDER C. KOLLIAS	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20080729, 20080428, 20060607</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The use of the trademarks ACTICIDE OTW, ARBOCEL BC 1000 and TYOLOSE MH 10001 P4 has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

2. Claim 26 is objected to because of the following informalities: Claim 26, Line3 recites "adding it after drying". The use of the pronoun "it" is confusing as it is unclear if the aqueous polymer dispersion or biocide is being referred to.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-18, 19-22, 24-25, 26, 27, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Weitzel et al (US 2003/0018121).

In setting forth the rejection of claims 11-17, the examiner notes that since these claims are drafted in Jepson format where the preamble is admitted prior art (whether to applicant or to

Art Unit: 1796

another), hence, absent contrary evidence, it is the non-preamble part of the claims that is to be analyzed for patentability over prior art.

Regarding claims 11-13 and 16-17 Weitzel et al discloses a water re-dispersible polymer powder composition comprising a re-dispersible polymer powder and a biocide which is prepared by spray drying (Abstract, Page 1 [0009], Page 2 [0016], [0018], Page 3[0023]). The reference discloses that the polymer is mixed in a dispersion with other ingredients such as fungicides are added to an aqueous dispersion and then spray dried (Page 3 [0023] and [Page 4 0038]). The reference discloses polymers such as homopolymer or copolymers comprising one or more monomers of vinyl esters, vinyl halides, methacrylate, 1,3-diene, vinyl-aromatic, olefin, and optionally further monomers (Page 1 [0009] and Page 2 [0015]). Additionally, the reference discloses copolymers such as vinyl acetate, ethylene, and a vinyl ester of alpha-branched monocarboxylic acid having 9 to 11 carbon atoms, or copolymers of styrene and one or more monomers such as methyl acrylate, ethyl acrylate, propyl acrylate, n-butyl acrylate or 2-ethylhexyl acrylate (Pages 1-2 [0016]).

Regarding claim 14-15, Weitzel et al discloses all the claim limitations as set forth above. Additionally, the reference discloses that the composition comprises a hydraulically setting miner binder such as cement, lime and gypsum (Page 4, [0032]).

Regarding claim 18, Weitzel et al discloses a process comprising adding a fungicide in the form of a dry composition containing at least one film form re-dispersible polymer powder , (Page 1 [0009], Page 2 [0016], [0018], Page 3 [0023]).

Regarding claims 19-22, and 27-28 Weitzel et al discloses a process of a curable, biocide containing building material comprising admixing building material components such as kaolin, clay, and silicates as well as optional additives such as gypsum, lime and cement and re-dispersible polymer powder, a biocide and water to form plaster, sealing compounds and emulsion paints (Page 3 [0028], [0030], and Page 4 [0032] [0038] and [0041]).

The reference discloses that biocides include such fungicides such as isothiazolines and benzisothiazolinone, specifically, n-octylisothiazoline (Page 3 [0028]). The biocides are added to the composition comprises 0.001 to 0.2 wt % base of the overall weight of the composition. It is noted that the amount of biocide disclosed by the reference is within the claimed range of 0.001 to 0.5 wt %.

Regarding claims 24-25, Weitzel et al discloses all the claim limitations as set forth above. Additionally, the reference discloses that the polymer in the process are homopolymer or copolymers comprising one or more monomers of vinyl esters, vinyl halides, methacrylate, 1,3-diene, vinyl-aromatic, olefin, and optionally further monomers (Page 1 [0009] and Page 2 [0015]). Additionally, the reference discloses copolymers such as vinyl acetate, ethylene, and a vinyl ester of alpha-branched monocarboxylic acid having 9 to 11 carbon atoms, or copolymers of styrene and one or more monomers such as methyl acrylate, ethyl acrylate, propyl acrylate, n-butyl acrylate or 2-ethylhexyl acrylate (Page 2 [0016]).

Art Unit: 1796

Regarding claim 26, Weitzel et al discloses all the claim limitations as set forth above. Additionally, the reference discloses that additives such as biocides are mixed into the aqueous polymer dispersions prior to or after drying (Page 4, [0038]).

Regarding claim 29, Weitzel et al discloses all the claim limitations as set forth above. Regarding the recited limitation that the building material does not contain hydraulically setting binders, the reference discloses that the hydraulically setting binders such as cement, lime, or gypsum may be added if desired (Abstract).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

Art Unit: 1796

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzel et al (US 2003/0018121).

The discussion with respect to Weitzel et al as set forth in Paragraph 4 above is incorporated here by reference.

Regarding the amount of biocide, recited in claim 23, the reference discloses that the composition comprises 0.001 to 0.2 wt % biocide (Page 4, [0028]). It is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Art Unit: 1796

*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

*Double Patenting: I*

10. Claims 11-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 2-3, 7-9, 11, and 14-15 of copending Application No. 11/112,778 in view of Weitzel et al (US 2003/0018121).

Claims 2-3, 7-9, 11, and 14-15 of copending Application No. 11/112,778 recite a dry coating composition comprising a copolymer and filler such as calcium carbonate. Specifically, claim 15 recites a polymer comprising vinyl acetate, ethyl and vinyl esters of alpha-branched monocarboxylic acid having 5 to 15 carbon atoms.

While the claims in both applications are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 2-3, 7-9, 11, and 14-15 of copending Application No. 11/112,778 lack such additional ingredients as biocides such as isothiazolines and benzisothiazolinone, specifically, n-octylisothiazoline and hydrological binders which are recited in the present claims

Weitzel et al a composition comprising a film forming polymer and a biocide such as isothiazolines and benzisothiazolinone (Abstract, Page 1, [0009], [0011], [0012], Page 2, [0016])



Art Unit: 1796

and Page 3, [0028]). Additionally, the reference disclose hydrological binders such as cement, lime and gypsum (Page (Page 4, [0032]))

Given that dry coating composition contain polymers and additives such as calcium carbonate, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of copending U.S. application 11/112,778 with the biocides and binders as disclosed by Weitzel et al thereby arrive at the presently claimed invention.

11. Claims 11-17 are directed to an invention not patentably distinct from Claims 2-3, 7-9, 11, and 14-15 of commonly assigned copending Application No. 11/112,778. Specifically, see the discussion set forth in Paragraph 10 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 11/112,778, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly

Art Unit: 1796

assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

This is a provisional obviousness-type double patenting rejection.

*Double Patenting: II*

12. Claims 11-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 13, 17-21, and 25 of copending Application No. 11/720,091 in view of Weitzel et al (US 2003/0018121).

Claims 13 and 17-21, and 24-25 of copending Application No. 11/720,091 recite a water re-dispersible polymer powder composition comprising a polymer. Specifically, the claims recites that the polymer comprises a vinyl acetate ether, vinyl acetate ethylene and a vinyl esters of alpha-monocarboxylic acids having up to 20 carbon atoms. Additionally, the claims recite such additives such as cement water, glass, gypsum and lime

While the claims in both applications are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 13, 17-21, and 25 of copending Application No. 11/720,091 lack such additional ingredients as biocides such as isothiazolines and benzisothiazolinone, which are recited in the present claims

Weitzel et al a composition comprising a film forming polymer and a biocide such as isothiazolines and benzisothiazolinone (Abstract, Page 1, [0009], [0011], [0012], Page 2, [0016] and Page 3, [0028]).

Given that dry coating composition contain polymers and binders such a gypsum, lime, glass, it would have been obvious to one of ordinary skill in the art at the time the invention was

Art Unit: 1796

made to modify the composition of copending U.S. application 11/720,091 with the biocides as disclosed by Weitzel et al thereby arrive at the presently claimed invention.

13. Claims 11-17 are directed to an invention not patentably distinct from Claims 13, 17-21, and 25 of commonly assigned copending Application No. 11/720,091. Specifically, see the discussion set forth in Paragraph 12 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 11/720,091, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

This is a provisional obviousness-type double patenting rejection.

*Double Patenting: III*

14. Claims 11-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 2, and 10 of U.S. Patent No. 5,753,733 in view of Weitzel et al (US 2003/0018121).

Claims 1, 2, and 10 of U.S. Patent No. 5,753,733 recite a water re-dispersible polymer powder composition comprising a polymer and additives. Specifically, the claims recites that the polymer comprises a vinyl acetate ether, vinyl acetate ethylene and a vinyl esters of alpha-monocarboxylic acids having up to 20 carbon atoms.

While the claims in both the U.S. Patent and the instant application are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1, 2, and 10 of U.S. Patent No. 5,753,73 lack such additional ingredients as biocides such isothiazolines and benzisothiazolinone as well as hydrological binders which are recited in the present claims

Weitzel et al a composition comprising a film forming polymer, biocides such as isothiazolines and benzisothiazolinone and hydrological binders such as cement, lime, and gypsum (Abstract, Page 1, [0009], [0011], [0012], Page 2, [0016], Page 3, [0028], and Page 4, [0032]).

Given that dry coating composition contain polymers and additives, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of U.S. Patent No. 5,753,73 with the biocides and binders as disclosed by Weitzel et al thereby arrive at the presently claimed invention.

Art Unit: 1796

15. Claim 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,753,733 in view of Weitzel et al (US 2003/0018121). Specifically, see the discussion set forth in Paragraph 14 above.

16. Claims 11-17 are directed to an invention not patentably distinct from Claims 1, 2 and 10 of commonly assigned U.S. Patent No. 5,753,733. Specifically, see the discussion set forth in Paragraph 14 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 5,753,733, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

*Double Patenting: IV*

Art Unit: 1796

17. Claims 19-24 and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 2 of U.S. Patent No. 6,191,235 in view of Weitzel et al (US 2003/0018121).

Claims 1 and 2 of U.S. Patent No. 6,191,235 recite a process for the preparation of a dispersion powder composition which is re-dispersible in water. Specifically, the claims recite that the polymer comprises homo- or copolymers of vinyl esters.

While the claims in both the U.S. Patent and the instant application are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1 and 2 of U.S. Patent No. 6,191,235 lack such additional method steps as adding ingredients such as biocides such as isothiazolines and benzisothiazolinone as well as hydrological binders which are recited in the present claims

Weitzel et al discloses the process of adding biocides such as isothiazolines and benzisothiazolinone and hydrological binders such as cement, lime, and gypsum to a dispersion powder composition (Abstract, Page 1, [0009], [0011], [0012], Page 2, [0016], Page 3, [0028], and Page 4, [0032]). Specifically, the reference discloses the amount of biocide is 0.001 to 0.2 wt % (Page 4, [0032]).

Given that processes of preparing dispersion powder compositions comprises the method steps of adding a vinyl ester homo- or copolymer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of U.S. Patent No. 5,753,73 to include the method steps of adding biocides and binders as disclosed by Weitzel et al thereby arrive at the presently claimed invention.

Art Unit: 1796

18. Claim 19-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,191,235 in view of Weitzel et al (US 2003/0018121). Specifically, see the discussion set forth in Paragraph 17 above.

19. Claims 19-24 and 27 are directed to an invention not patentably distinct from Claims 1 and 2 of commonly assigned U.S. Patent No. 6,191,235. Specifically, see the discussion set forth in Paragraph 17 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,191,235, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

*Double Patenting: V*

Art Unit: 1796

20. Claims 11-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 5 of U.S. Patent No. 6,429,239 in view of Weitzel et al (US 2003/0018121).

Claims 1 and 5 of U.S. Patent No. 6,429,239 recite a water re-dispersible polymer powder composition comprising a polymer such a vinyl ester homo- or copolymers and inorganic hydrological binders.

While the claims in both the U.S. Patent and the instant application are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1 and 5 of U.S. Patent No. 6,429,239 lack such additional ingredients as biocides such isothiazolines and benzisothiazolinone as well as gypsum, lime or cement additives which are recited in the present claims

Weitzel et al a composition comprising a film forming polymer, biocides such as isothiazolines and benzisothiazolinone and hydrological binders such as cement, lime, and gypsum (Abstract, Page 1, [0009], [0011], [0012], Page 2, [0016], Page 3, [0028], and Page 4, [0032]).

Given that dry coating composition contain polymers and additives, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of U.S. Patent No. 6,429,239 with the biocides and binders as disclosed by Weitzel et al thereby arrive at the presently claimed invention.



Art Unit: 1796

21. Claim 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,429,239 in view of Weitzel et al (US 2003/0018121). Specifically, see the discussion set forth in Paragraph 120 above.

22. Claims 11-16 are directed to an invention not patentably distinct from Claims 1 and 5 of commonly assigned U.S. Patent No. 6,429,239. Specifically, see the discussion set forth in Paragraph 20 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,429,239, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

*Double Patenting: VI*

Art Unit: 1796

23. Claims 11-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 1, 2, and 5 of U.S. Patent No. 6,660,079 in view of Weitzel et al (US 2003/0018121).

Claims 1, 2, and 5 of U.S. Patent No. 6,660,079 recite a water re-dispersible polymer powder composition comprising a re-dispersible polymer comprising vinyl ester monomers and a binder such as cement.

While the claims in both the U.S. Patent and the instant application are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1 and 5 of U.S. Patent No. 6,660,079 lack such additional ingredients as biocides such as isothiazolines and benzisothiazolinone which are recited in the present claims

Weitzel et al a composition comprising a film forming polymer, biocides such as isothiazolines and benzisothiazolinone and hydrological binders such as cement, lime, and gypsum (Abstract, Page 1, [0009], [0011], [0012], Page 2, [0016], Page 3, [0028], and Page 4, [0032]).

Given that dry coating composition contain polymers and additives, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of U.S. Patent No. 6,429,239 with the biocides and binders as disclosed by Weitzel et al thereby arrive at the presently claimed invention.

24. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,660,079, in view of Weitzel et al (US 2003/0018121). Specifically, see the discussion as set forth in Paragraph 23 above.

Art Unit: 1796

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Specifically, see the discussion as set forth in Paragraph 23 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,660,079, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that

Art Unit: 1796

the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

*Double Patenting: VII*

25. Claims 11-13 and 16-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-2, 5, 11-12, 15, and 17 of U.S. Patent No. 6,740,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Claims 1-2, 5, 11-12, 15, and 17 of U.S. Patent No. 6,740,692 recite a water re-dispersible polymer powder composition comprising a re-dispersible polymer comprising vinyl ester monomers or copolymers comprising vinyl acetate, ethylene and vinyl esters of alpha-branched monocarboxylic acids having from 9 to 11 carbon atoms. Additionally, the claimed recite a biocide such as isothiazolines and benzisothiazolinone. The scope of the instant claims encompasses the scope of the claims in U.S. Patent No. 6,740,692.

26. Claims 11-13 and 16-17 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,740,692. Specifically, see the discussion as set forth in Paragraph 25 above.

Art Unit: 1796

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Specifically, see the discussion as set forth in Paragraph 25 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,740,692, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that

Art Unit: 1796

the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

*Double Patenting: VIII*

27. Claims 11-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-2, 5-10,12-13, 15, and 17-23, 11-12 of U.S. Patent No. 7,183,358 in view of Weitzel et al (US 2003/0018121).

Claims 1-2, 5-10,12-13, 15, and 17-23, 11-12 of U.S. Patent No. 7,183,358 recite a water re-dispersible polymer powder composition comprising a re-dispersible polymer comprising vinyl ester monomers or a copolymer comprising vinyl acetate, ethylene and vinyl ester of an alpha-branched monocarboxylic acid comprising 9 to 13 carbon atoms.. Additionally, the claims recite that the composition comprises hydraulically setting inorganic binder such as cement, gypsum, and lime..

While the claims in both the U.S. Patent and the instant application are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1-2, 5-10,12-13, 15, and 17-23, 11-12 of U.S. Patent No. 7,183,358 lack such additional ingredients as biocides such as isothiazolines and benzisothiazolinone which are recited in the present claims

Art Unit: 1796

Weitzel et al a composition comprising a film forming polymer, biocides such as isothiazolines and benzisothiazolinone and hydrological binders such as cement, lime, and gypsum (Abstract, Page 1, [0009], [0011], [0012], Page 2, [0016], Page 3, [0028], and Page 4, [0032]).

Given that dry coating composition contain polymers and additives, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of U.S. Patent No. 6,429,239 with the biocides as disclosed by Weitzel et al thereby arrive at the presently claimed invention.

28. Claims 11-13 and 16-17 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 7,183,358. Specifically, see the discussion as set forth in Paragraph 27 above.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the

Art Unit: 1796

reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C.

103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Specifically, see the discussion as set forth in Paragraph 27 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 7,183,358, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. PGpub No. US 2002/0011187 discloses a coating system comprising a dry powder composition but does not comprise a biocide. U.S. Patent No. 4,743,475 is drawn to a drywall composition comprising a fungicide and a polymer but lacks gypsum or cement.



Art Unit: 1796

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER C. KOLLIAS whose telephone number is (571)-270-3869. The examiner can normally be reached on Monday-Friday, 8:00 AM -5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C. K./  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796